

ESTTA Tracking number: **ESTTA663495**

Filing date: **03/27/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91212906
Party	Defendant Cashsquare Inc.
Correspondence Address	LEONARD GRAYVER GREENBERG WHITCOMBE TAKEUCHI LLP 21515 HAWTHORNE BLVD, STE 450 TORRANCE, CA 90503 6531 UNITED STATES lgrayver@gwtllp.com
Submission	Reply in Support of Motion
Filer's Name	Leonard Grayver
Filer's e-mail	lgrayver@gwtllp.com,jbenavides@gwtllp.com,amccracken@gwtllp.com
Signature	/s/
Date	03/27/2015
Attachments	Reply to Opposition to Motion to Amend.032715.pdf(311593 bytes) Declaration of Abaev in Support of Reply to Opposition to Motion to Amend.032715.pdf(361591 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of
Trademark Application Serial No. 85/827,823
Published in the Official Gazette: June 11, 2013
Mark: CASHSQUARE

Square, Inc.,)	
)	
Opposer,)	
v.)	Opposition No. 91212906
)	
)	
Cashsquare, Inc.,)	
)	
Applicant.)	
_____)	

Commissioner for Trademarks
P.O. Box 1451
Alexandria, Virginia 22313-1451

**APPLICANT’S REPLY TO OPPOSER’S OPPOSITION
TO APPLICANT’S AMENDED MOTION TO AMEND APPLICATION
AFTER NOTICE OF OPPOSITION**

Applicant, Cashsquare, Inc., (“Applicant”) hereby replies to Opposer Square, Inc.’s Opposition to Applicant’s Amended Motion to Amend Application After Notice of Opposition (hereinafter, the “Opposition Brief” and “Opp. Brief”).

In the Opposition Brief, Opposer Square, Inc. (“Opposer”) makes, essentially, three fallacious arguments why the Motion should be denied: (1) Opposer claims deletion of the

“dot” at issue results in a material alteration of the Original Mark; (2) Opposer claims the Original Mark does not support the proposed amendment and, therefore, a substitute specimen should have been submitted to support the Motion; and (3) Opposer requests the Board deny the Motion to punish Applicant for purported “inconsistencies” in its discovery responses.

As explained more fully herein, these arguments are disingenuous, unsupported by the facts, and are obvious attempts by Opposer to distract from the simple truth that deletion of the “dot” from the stylized Q in the Original Mark in the Application does not amount to a “material alteration” of the Mark.

ARGUMENT

I. The Proposed Amended Mark Maintains the Same Commercial Impression As the Original Mark.

In the Opposition Brief, for five and one-half pages, Opposer ties itself in logical knots and applies tortured logic to try and convince this Board that the simple act of removal of a “dot” in the Original Mark amounts to a material alteration. It simply does not.

Again, for purposes of reference and comparison, the following is a side-by-side comparison of the Mark before and after the proposed amendment:

Before: **cashsquare**

After: **cashsquare**

In support of this line of argument, Opposer first argues that removal of the “dot” from the Q in Original Mark “would materially alter the original mark because it removes what Applicant admits is a material component” of the Original Mark. *See* Opp. Brief, p.7. In support of this Opposer also cites to Applicant’s Response to Interrogatory No. 2. However, upon closer read of the interrogatory response, it is clear Opposer is overreaching and presenting to this Board only an excerpt of the response, taken wholly out of context.

The relevant paragraph of that interrogatory response reads, in its entirety, as follows:

“The stylized Q was developed by a web designer who sold it to the company. **The stylized Q was determined to be the most aesthetically pleasing** of several options presented by the web designer. **The stylized Q was also chosen because it was visually similar to a pin** that could be placed on a map location.” (Emphasis added.)

Contrary to Opposer’s contention in the Opposition Brief, there is no “admission” in this response that the “dot” at issue is a “material component that contributes substantially to a consumer’s commercial impression of the CASHSQUARE Mark[.]” *See* Opp. Brief, p.8. Indeed, the response makes no statement whatsoever regarding the objective commercial impression conveyed by the “dot” -- rather the response speaks to the *subjectively* pleasing overall “aesthetic” of the CASHSQUARE Mark and the *subjective* impression that the “dot” within the “Q” was subjectively similar to a pin on a map.

Nonetheless, as Opposer well knows, the *subjective* impressions of Applicant regarding the Original Mark is not at issue in the Motion. The controlling question is “**always whether**

the old and new forms of the mark create essentially the same commercial impression.”

TBMP § 807.14 (Emphasis added.)

A review of the Original and proposed Amended Marks, above, make clear that Applicant’s proposed amendments do not change the essential nature or character of the Original Mark. Here, the name, the words arrangement, and the essence of the design of the O Original Mark are all maintained in the Amended Mark; clearly the proposed amendment is trivial. Applicant’s Motion for Leave to Amend should be granted.

With this argument bound to fail, Opposer then argues that the “dot” should be treated like a “punctuation mark” which -- although not always -- “*can* [sometimes] materially alter an original mark **if the addition or deletion changes the overall commercial impression of the mark.**” *See* Opp. Brief, p.8. (Italics in original; emphasis added.)

Here, Opposer is engaged in circular logic. As discussed, it does not matter if the “dot” at issue is treated like punctuation or a graphic design -- the controlling issue is whether its removal results in an *objective* change in “commercial impression” when viewed from the perspective of an average consumer. For reasons fully discussed above, and in the Motion, it plainly does not.

Put another way, punctuation is often used to convey an inherent and instantly identifiable desire or instruction regarding tone and/or delivery of a commercial brand. For example, to an average consumer an exclamation point conveys excitement or forcefulness. A question mark conveys a question or equivocation. A colon or dash often conveys a pause or

the joining of two traditionally independent or dissimilar concepts. However, the “dot” at issue here cannot be said to convey any similarly identifiable concept, message, or tone. To the average consumer it’s simply a “dot.” For these reasons, the several “punctuation” cases cited in the Opposition Brief are inapposite. *See* Opp. Brief, pgs.8-9.

Moreover, in its Opposition Brief, Opposer tellingly fails to specifically identify how or why removal of the “dot” would amount to a material alteration of the Mark -- because such a position is unsupportable on these facts. As a result, Opposer is left to argue its position in vague conclusory statements. *See* Opp. Brief, p.10. (“Removal of the ‘dot’ changes the essence of the mark[.]”; “A change in the design of the Mark such as removal of the ‘dot’ ultimately results in a different commercial impression[.]”)

In sum, Opposer’s arguments are plainly distractionary and disingenuous. Omission of the “dot” does not, and cannot, amount to a material alteration of the Original Mark as a matter of law. Accordingly, the Board should grant the Motion.

II. Opposer’s Demand for a Substitute Specimen is an Exercise in Circular Logic and Presupposes the Amendment Materially Alters the Original Mark.

In its Opposition Brief, Opposer also claims that “Applicant was required to submit a substitute specimen and an affidavit or declaration[.]” under Trademark Rule 2.72(a)(1) since -- according to Opposer -- the “[removal of the ‘dot’] materially alters the original Mark[.]” *See* Opp. Brief, p.11. Again, this argument is misleading, relies on circular logic, and is a clear misapplication/misunderstanding of the applicable Rule.

Trademark Rule 2.72(a) states in its entirety, as follows:

“(a) In an application based on use in commerce under section 1(a) of the Act, the applicant may amend the description or drawing of the mark only if: [¶] (1) The **specimens originally filed, or substitute specimens filed** under § 2.59(a), **support the proposed amendment**; and [¶] (2) The proposed amendment does not materially alter the mark. The Office will determine whether a proposed amendment materially alters a mark **by comparing the proposed amendment with the description or drawing of the mark filed with the original application.**” (Emphasis added.

Applicant maintains the Original Mark in the Application (**cashsquare**) plainly supports the proposed Amended Mark (**cashsquare**) since the Original Mark contains all the defining characteristics of the proposed Amended Mark and conveys the same overall commercial impression. Therefore, a substitute specimen is not required and Opposer’s demand for a substitute specimen (and supporting declaration) is inappropriate. The Motion can and should be granted.

III. The Alleged Discovery “Inconsistencies” Are an Intentional Red Herring and Not Valid Grounds to Deny Applicant’s Motion.

In a final desperate attempt to convince the Board to deny the Motion, Opposer claims that “Applicant has failed to explain why it seeks to modify the ‘CASHSQUARE’ mark when it admits to abandoning either version of its ‘CASHSQUARE’ mark in favor of the ‘Cash²’ mark.” *See* Opp. Brief, pgs.11-12. Without a legal basis or supporting case precedent -- and

without any explanation of how such “discovery inconsistencies” are relevant to the instant Motion -- Opposer claim these responses constitute “discovery abuse” and requests the Board deny the Motion to punish Applicant for these purported “inconsistencies” in its discovery responses. This request is unsupportable in law and improper.

First, Applicant did not “explain” why it *subsequently* abandoned the “Cash²” Mark, in favor of the “CASHSQUARE” Mark because it was then -- and is now -- irrelevant to the issues raised in the Motion. Nonetheless, in an effort to briefly respond to Opposer’s red herring of an argument, Applicant respectfully requests the Board to review Boris Abaev’s Declaration In Support of Applicant's Reply to Opposer Square, Inc.’s Opposition to Applicant's Amended Motion to Amend Application After Notice of Opposition (hereinafter, the “Abaev Declaration”).

As explained therein, Mr. Abaev (“Abaev”) is the 27 year-old founder of Cashesquare. *See* Abaev Declaration at ¶1. In mid-September 2014, while the instant trademark dispute was ongoing and before Applicant’s discovery responses were prepared on September 24, 2014 -- out of concern that a protracted and costly legal dispute with a billion dollar behemoth that is the Opposer could deplete the then-limited financial resources of Abaev and Applicant -- Abaev made the decision to start using the “Cash²” Mark. *See* Abaev Declaration at ¶4. This decision was made purely for business reasons and to spare Applicant from incurring additional legal expenses and attorneys’ fees, which he could not afford. *See* Abaev Declaration at ¶5.

Shortly thereafter, on September 24, 2014, Abaev verified the discovery responses at issue and, therein, represented that Cashsquare had “abandoned” the Original Mark in favor of the “Cash²” Mark. *See* Abaev Declaration at ¶6. These responses were true and accurate when given. *See* Abaev Declaration at ¶6.

Subsequently in mid-November, and after thoroughly discussing the matter with business associates, consultants, and legal counsel -- Abaev decided that he should not cower to the pressure from the Opposer and that it was in Applicant’s best interest to maintain the Original Mark. Therefore, Abaev sought leave from the Board to amend the Original Mark as requested in the Motion. *See* Abaev Declaration at ¶7. Thus, the total period of “abandonment” of the Original Mark complained of by Opposer is believed to be less than *two months*. *See* Abaev Declaration at ¶8. Opposer has not, and cannot, produce any legal authority suggesting these facts warrant a denial of the Motion.

CONCLUSION

For the aforementioned reasons, Applicant respectfully requests the Board grant the instant Motion and grant Applicant leave to amend its Application as set forth in the Motion.

Dated: March 26, 2015

Respectfully Submitted,



Leonard Grayver
Greenberg, Whitcombe, Takeuchi, Gibson
& Grayver, LLP
21515 Hawthorne Blvd., Suite 450
Torrance, CA 90503

PROOF OF SERVICE

STATE OF CALIFORNIA, COUNTY OF LOS ANGELES

I am employed in the County of Los Angeles, State of California. I am over the age of 18 and not a party to the within action; my business address is 21515 Hawthorne Boulevard, Suite 450, Torrance, California 90503-6531.

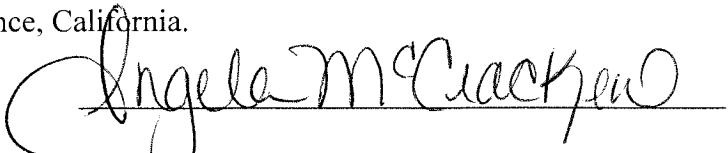
On March 27, 2015, I served the foregoing document(s) described as APPLICANT'S REPLY TO OPPOSER'S OPPOSITION TO APPLICANT'S AMENDED MOTION TO AMEND APPLICATION AFTER NOTICE OF OPPOSITION on the interested parties in this action by placing a true copy thereof enclosed in a sealed envelope addressed as follows:

Connie L. Ellerbach, Esq.
Fenwick & West
801 California Street
Mountain View, CA 94041
cellerbach@fenwick.com

(X) **BY MAIL:** I am "readily familiar" with the firm's practice of collection and processing correspondence for mailing. Under that practice it would be deposited with the U.S. Postal Service on that same day with postage thereon fully prepaid at Torrance, California, in the ordinary course of business. I am aware that on motion of the party served, service is presumed invalid if postal cancellation date or postage meter date is more than one day after the date of deposit for mailing in affidavit. *CCP §1013(a); Fed. Rule Civ. Proc. 5(b)*.

(X) **FEDERAL** I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct. *28 U.S.C. §1746*.

Executed on March 27, 2015, at Torrance, California.


Angela McCracken

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of
Trademark Application Serial No. 85/827,823
Published in the Official Gazette: June 11, 2013
Mark: CASHSQUARE

Square, Inc.,)	
)	
Opposer,)	
v.)	Opposition No. 91212906
)	
)	
Cashsquare, Inc.,)	
)	
Applicant.)	
_____)	

Commissioner for Trademarks
P.O. Box 1451
Alexandria, Virginia 22313-1451

**DECLARATION OF BORIS ABAEV IN SUPPORT OF APPLICANT’S REPLY TO
OPPOSER’S OPPOSITION TO APPLICANT’S AMENDED MOTION TO AMEND
APPLICATION AFTER NOTICE OF OPPOSITION**

I, Boris Abaev, declare as follows:

1. I am the founder of Applicant, Cashsquare, Inc. (“Applicant”). I am over the age of eighteen, and am presently a resident of Moscow, Russia.
2. This Declaration is based upon facts personally known to me, and if called upon to testify to any of the below facts, I could and would testify competently to the same.

///

3. This Declaration is filed in support of Applicant's Reply to Opposer's Opposition to Applicant's Amended Motion to Amend Application After Notice of Opposition.

4. In mid-September 2014, while the instant trademark dispute was ongoing and before Applicant's discovery responses were prepared on September 24, 2014 -- out of concern that a protracted and costly legal dispute with a billion dollar behemoth that is the Opposer could deplete the then-limited financial resources of mine and of Applicant, I made the decision to start using the "Cash²" Mark.

5. The decision to start using the "Cash²" Mark was made purely for business reasons and to spare Applicant from incurring additional legal expenses and attorneys' fees, which we could not afford at the time.

6. Shortly thereafter, on September 24, 2014, I verified the discovery responses at issue and, therein, represented that Cashsquare had "abandoned" the Original Mark in favor of the "Cash²" Mark. Those discovery responses and representations were true and accurate when given.

7. Subsequently in mid-November, and after thoroughly discussing the matter with business associates, consultants, and legal counsel, I decided that Applicant and I should not cower to the pressure from the Opposer and that it was in Applicant's best interest to maintain the Original Mark. Therefore, on or about that time, through counsel Applicant sought leave from the Board to amend the Original Mark as requested in the Motion.

8. Thus, the total period of "abandonment" of the Original Mark complained of by Opposer is believed to be less than *two months*.

I declare under penalty of perjury under the laws of the United States of America, and under the laws of the State of California, that the foregoing is true and correct, and that this declaration was executed on March 26, 2015 in MOSCOW, RUSSIA.



Boris Abaev

PROOF OF SERVICE

STATE OF CALIFORNIA, COUNTY OF LOS ANGELES

I am employed in the County of Los Angeles, State of California. I am over the age of 18 and not a party to the within action; my business address is 21515 Hawthorne Boulevard, Suite 450, Torrance, California 90503-6531.

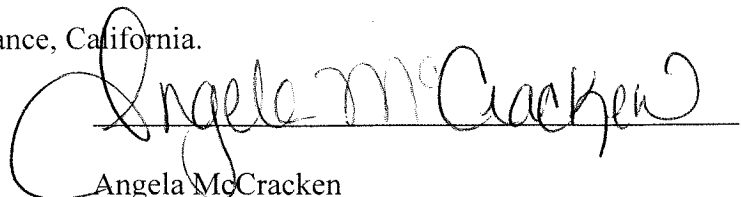
On March 27, 2015, I served the foregoing document(s) described as **DECLARATION OF BORIS ABAEV IN SUPPORT OF APPLICANT'S REPLY TO OPPOSER'S OPPOSITION TO APPLICANT'S AMENDED MOTION TO AMEND APPLICATION AFTER NOTICE OF OPPOSITION** on the interested parties in this action by placing a true copy thereof enclosed in a sealed envelope addressed as follows:

Connie L. Ellerbach, Esq.
Fenwick & West
801 California Street
Mountain View, CA 94041
cellerbach@fenwick.com

(X) **BY MAIL:** I am "readily familiar" with the firm's practice of collection and processing correspondence for mailing. Under that practice it would be deposited with the U.S. Postal Service on that same day with postage thereon fully prepaid at Torrance, California, in the ordinary course of business. I am aware that on motion of the party served, service is presumed invalid if postal cancellation date or postage meter date is more than one day after the date of deposit for mailing in affidavit. *CCP §1013(a); Fed. Rule Civ. Proc. 5(b)*.

(X) **FEDERAL** I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct. *28 U.S.C. §1746*.

Executed on March 27, 2015, at Torrance, California.


Angela McCracken